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EXAMINER
KYLE, MICHAEL J

ART UNIT	PAPER NUMBER
3676	

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _22 January 2004_.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-20_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-20_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _10282003_.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2.   Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Petravich et al

("Petravich", U.S. Patent No. 6,101,483). Petravich discloses a method for using a purchasing

aid logistics appliance (40) comprising downloading product data from a web site or bar coded

advertisement, creating a shopping list from said product data, transmitting said shopping list to a

merchant computer upon entry into a merchant facility (24 linked to 16), receiving product data

from said merchant computer upon entry into said merchant facility (column 7, lines 18-27),

scanning a product bar code when a product is removed from the shelf and placed in a shopping

cart for purchase (column 12, lines 35-36), creating a shopping cart file when said product is

scanned (column 12, lines 36-40), and transmitting said shopping cart file to said merchant

computer to checkout (column 12, lines 49-57). The hard copy of the shopping list described in

column 7, lines 18-27, inherently includes product data, as a way to identify the product.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.   Claims 1, 4, 5, 9, 11, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petravich et al ("Petravich", U.S. Patent No. 6,101,483) in view of Ruppert et al ("Ruppert", U.S. Patent No. 5,424,524). Petravich discloses a portable 2-way secure purchasing aid logistics appliance (40), comprising means for inputting information (column 4, lines 55-61), and a central processor coupled to said means for inputting information to generate a shopping list (column 5, line 37). Petravich also discloses means for securing memory coupled to said central processor to safeguard personal and financial information (column 4, lines 19-22 and 55-61), means for outputting said shopping list (column 12, lines 49-57), and said personal and said financial information, and a display (72) to view said shopping list. Petravich fails to disclose the central processor to include application software to maintain a budget and to perform finance computations.

5.   Ruppert teaches a personal scanner device to aid shoppers, where the scanner device maintains a budget (26) and performs finance computations (calculates running total). These functions are presented in the abstract of Ruppert. These features aid shoppers in keeping track of their expenditures (Abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Petravich as taught by Ruppert, such that the central processor of Petravich's appliance maintains a budget and performs finance computations, in order to aid shopper in keeping track of their expenditures.

6.   With respect to claim 4, Petravich discloses the means for inputting information is a bar code scanner, whereby said bar code scanner (column 4, line 57) scans print media bar codes

having product information and generates bar code signals to said central processor for further processing.

7.   With respect to claim 5, the combination of Petravich and Ruppert disclose the central processor to compare the shopping list to said bar code signals to determine whether product is a new product to add to said shopping list or an existing product (column 10, lines 1-18), whereby said central processor tracks the total cost of products scanned, the remaining products to be scanned, and the available funds remaining in the budget.

8.   With respect to claim 9, Petravich et al discloses inputting credit or debit card information with a magnetic strip reader (column 5, line 61).

9.   With respect to claim 11, Petravich discloses the central processor transmits a first signal to said means for outputting, whereby said means for outputting transmits said first signal to a merchant computer (56 linked to 16).

10.   With respect to claim 13, Petravich discloses a shopping list being output to a merchant computer first (column 12, lines 53-56). Because the shopping list is the only item transmitted to the merchant computer, it is the first.

11.   With respect to claim 15, Petravich et al discloses the means for outputting includes a radio transmitter (radiophone).

12.   Claims 2, 3, 8, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petravich in view of Rupport as applied to claim 1 above, and further in view of WO 01/20526 (WO '526). Neither Petravich nor Ruppert disclose the means for inputting information to be a

radio receiver that receives signals from a radio transmitter coupled to a merchant computer or

an internet port that is connectable to a personal computer linked to a merchant web site.

13.   WO '526 teaches a shopping list organizer comprising a portable device (112) where

information may be input to the portable device (112) by a radio receiver or an internet port.

WO '526 describes inputting information by placing the portable device (112) in a "cradle"

(page 15, line 29). WO '526 continues to recite that instead of a cradle, the portable device may

communicate with an in store computer by radio (page 18, lines 26-29). A radio receiver and

transmitter as claimed must be included in this arrangement described by WO '526 in order to

facilitate the radio communication. Inputting information by radio transmissions reduces

hardware costs by eliminating peripheral components, such as cradles. It also allows for a

greater flexibility in the location of the user. It would have been obvious to one having ordinary

skill in the art at the time of the invention to modify Petravich and Rupport, such that the means

for inputting information is a radio receiver, to reduce peripheral hardware costs and allow

flexibility in the location of the user.

14.   With respect to claim 3, the portable device taught by WO '526 may be coupled to a

desktop computer where it can be configured to download information from a merchant web site

("various sites", page 11, line 25). This process is described on page 11, lines 19-26. Examiner

considers the device used to couple the portable device (112) to the desktop computer to be the

internet port. While this device is not described, it is inherent based on the disclosure of the

system in WO '526. Inputting information via an internet port allows the user to input

information into the portable device while at home, and does not require the user to have any

extra bar codes or codes present in order to enter an item to a list. It would have been obvious to

one having ordinary skill in the art at the time of the invention to modify Petravich and Rupport as taught by WO '526, such that means for inputting information includes an internet port, so the user may add items to a list while at home, without having any other product information available, such as a bar code.

15.   With respect to claim 8, neither Petravich nor Ruppert discloses inputting information with a keypad. It is well known in the art to use a keypad to enter information, as taught by WO '526. In addition, keypads are commonly used to input information when bar code readers or magnetic card readers fail. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to input information in the combination Petravich and Ruppert by using a keypad, as shown by WO'526.

16.   With respect to claims 12 and 14, neither Petravich nor Rupperts discloses the first signal to comprise a credit or debit card number and personal identification number.

17.   WO '526 teaches a method of electronic payment where either credit card or debit card numbers (page 16, lines 19-20) and a PIN number ("customer identification number") are transmitted to a merchant computer. Examiner notes that applicant has not provided any criticality for the credit or debit card information, along with a PIN number, to be the first signal, rather than the shopping list. Transmitting the customer's payment data before the shopping list appears to be a design choice, as no new or unexpected result arises from such a transaction. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination of Petravich and Ruppert as taught by WO '526, such that either a credit card number or debit card number, along with a PIN number is the first signal transmitted to a merchant computer, as a matter of design choice.

18.   Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petravich in view of Ruppert as applied to claim 4 above, and further in view of Shaw (U.S. Patent No. 6,568,596). Neither Petravich nor Ruppert disclose the central processor to include software that converts the bar code signals into a web page to be displayed on the display

19.   Shaw teaches a method where a bar code is converted into a web page (column 3, line 51 to column 4, line 6) and displayed. This method allows information to be published in near real time, as the scanned information is already in a markup language. This also eliminates discrete stages of data collection and data manipulation before publication (column 1, lines 9-13). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Petravich and Ruppert as taught by Shaw such that central processor includes software to convert bar codes into a web page. This allows for quicker publication of a scanned item.

20.   Shaw discloses only the use of XML, but states that, "any other suitable markup language may also be used" (column 2, line 14). An XML decoder, and a parser having a modifying table are inherent in Shaw's invention, as they must be present to decode the markup language and construct frame software. A display browser is also inherent in Shaw. The bar code containing the XML script can be converted into a web page. Shaw does not explicitly provide the decoder to have HTML, JAVA, and WAP decode tables, or that HTML, JAVA, or WAP script can be converted into a web page. However, because the use of HTML, JAVA, WAP, and XML are all well known in the art to create web sites, Official Notice is taken that HTML, JAVA, and WAP script may be substituted for the XML script of Shaw. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination of Petravich,

Ruppert, and Shaw, such that the bar codes of Shaw may contain HTML, JAVA, or WAP script,

and the decoder has HTML, JAVA, and WAP decode tables.

21.   Claims 10, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Petravich in view of Ruppert as applied to claim 1 above, and further in view of Ogasawara (U.S.

Patent No. 6,123,259). With respect to claims 10 and 17, Petravich and Ruppert fail to disclose a

smart card reader and a smart card storing a user personal identification number.

22.   Ogasawara teaches a portable shopping device that interfaces with a smart card (column

6, lines 12-36). The smart card contains pertinent user data. By using a smart card, the user data

is secured access to personal information is limited. Therefore, it would have been obvious to

one having ordinary skill in the art at the time the invention was made to modify Petravich and

Ruppert as taught by Ogasawara in order to limit access to personal information.

23.   With respect to claim 16, Petravich and Ruppert fail to disclose the means for outputting

to control signal strength to minimize the possibility of transmission interception. Ogasawara

teaches a portable shopping device that communicates with an external information source

terminal by a wireless communication transceiver. The radio frequency is controlled from about

900 MHz to 2.4GHz (column 5, lines 19-42). Examiner notes that Ogasawara discloses the

claimed structure, and for this reason is capable of performing the claimed function.

Specifically, Ogasawara discloses the radio signal strength to be controlled when communicating

with another terminal, or merchant sales register, as claimed. Because Ogasawara's signal

strength is controlled, it is capable of minimizing the possibility of transmission interception. It

would have been obvious to one having ordinary skill in the art at the time of the invention to

modify Petravich and Ruppert as taught by Ogasawara in order to minimize the possibility of

transmission interception.

24.   Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Petravich in view of WO '526 and Ruppert. Petravich discloses a purchasing aid logistics

appliance (40) comprising means for creating a shopping list outside a merchant facility (32, 16),

means for storing said shopping list and user personal information (16, 40), means for

automatically uploading said shopping list to a merchant computer upon entry into said merchant

facility (24) and means for two-way data and voice communication (column 12, lines 9-27) with

said merchant computer. Petravich also discloses means for displaying said shopping list (72),

and means for optically inputting product information data (bar code reader). The means for

storing is secure. Petravich does not disclose means for electronic payment or means for

calculating the total price of the items, as claimed.

25.   WO '526 teaches a shopping list organizer comprising a portable device (112). The

portable device includes means for making an electronic payment (page 16, lines 8-31).

Electronic payments allow for payments to be made more quickly, and do not require the user to

carry any additional method of payment. It would have been obvious to one having ordinary

skill in the art at the time of the invention to modify Petravich as taught by WO '526, in order to

make quicker payments, and allow the user to make payments without carrying any additional

payment devices.

26.   Ruppert teaches a personal scanner device to aid shoppers, where the scanner device

includes means for calculating the total price of the items (Abstract). These functions are

presented in the abstract of Ruppert. These features aid shoppers in keeping track of their

expenditures (Abstract). Therefore, it would have been obvious to one having ordinary skill in

the art at the time of the invention to modify Petravich as taught by Ruppert, such that the central

processor of Petravich's appliance maintains a budget and performs finance computations, in

order to aid shopper in keeping track of their expenditures.

Response to Arguments

27.   Applicant's arguments with respect to claims 1-7, 9, 11, 13, 15, 16, and 19 have been

considered but are moot in view of the new ground(s) of rejection. Ruppert has been cited to

teach maintaining a budget and perform finance computations, WO '526 has been cited to teach

means for inputting information to be a radio receiver or internet port, and Ogasawara has been

cited to teach the controlling of a signal strength. Additionally, WO '526 and Ruppert have been

cited in the rejection of claims 19 and 20. Shaw has been cited in the rejections of claims 6 and 7

to show a bar code that converted into a web page when scanned.

28.   Regarding claim 1, applicant argues presenting security codes and identification

information to a portable terminal is fundamentally different that securing the memory, as

claimed by applicant. Applicant relies on passages (paragraph 47) in the specification of the

present application to define over the means for securing the memory of Petravich, as considered

by the examiner. Examiner notes that the limitations of paragraph 47 of the specification of the

present application are not present in the claims. Applicant's argument appears to be narrower

than the claimed limitations. Examiner maintains that the memory coupled to the central

processor of Petravich is secure in that security codes and identification information must be presented to access the information.

29.   With respect to claim 18, applicant argues that examiner has not provided citations in Petravich for three of the steps, and that the steps do not appear to be present in Petravich. Examiner has now cited relevant passages in Petravich (see rejection of claim 18 above) that meet the limitations of claim 18, and maintains the rejection.

30.   With respect to claim 19, applicant argues that Petravich does not have means for automatically uploading the shopping list to a merchant facility upon entering the merchant facility. Applicant notes that act of docking the purchasing aid logistic appliance in a cradle, as Petravich does, contradicts the act of being automatic. Examiner notes the term "automatic" is considered broadly, in the sense that the user in Petravich is not manually uploading the shopping the list to the merchant computers database. This process is carried out by the computers. Whether or not a user initiates the uploading process, is not part of the uploading process.

31.   With respect to claim 8, applicant argues that the keyboard taught by WO '526 teaches away from keypad presented in the claim. Examiner notes, that as claimed, the keyboard of WO '526 and the keypad of the present application are identical, as there no structure assigned to the claimed keypad.

Conclusion

32.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Michael J Kyle whose telephone number is 703-305-3614. The

examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

33.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather Shackelford can be reached on 703-308-2978. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

34.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mk

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